

REMARKS/ARGUMENTS

Claims 17-34 are pending in the application. Claims 17, 20, 26, and 29 are amended, and claims 35 and 36 are added. The amendments to the claims as indicated herein do not add any new matter to this application. Furthermore, amendments made to the claims as indicated herein have been made to exclusively improve readability and clarity of the claims and not for the purpose of overcoming alleged prior art. The various issues within the Office Action will now be addressed in their order of appearance.

Claims 20 and 29 stand objected to because of a misspelling (Office Action, Page 3, Section 7). In response, Claims 20 and 29 have been amended.

Claims 20 and 29 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly being non-enabling (Office Action, Page 3, Section 9). This rejection is respectfully traversed. The paragraph beginning at page 7, line 4 of Applicant's specification reads as follows:

Web server 106 may, at the user's request from client 102, retrieve data from sponsored search server 108, application server 110, page after cookie server 112, or any other server that can be used in the above example. Communicating with sponsored search server 108 is repository 114. Repository 116 may also be exchanging data with page after cookie server 112. Repositories 114 and 116 can be used to store data from other system 100 components. For example, page after cookie server 112 may store cookies, IDs, tokens, or other related information in repository 116. Sponsored search server 108 may store sponsored advertisements, sponsored search results, search terms related to sponsored searches, text, images, or other sponsored content in repository 114. Servers 106-112 may also be shown with other repositories, storage utilities, or memory components for storing data used by system 100.

From the above it is apparent that a variety of items may be stored within the repository 114, and thus exist prior to a user initiating a search. Because of this prior existence, the term "pre-existing" is supported within Applicant's specification. Consequently, the rejection of Claims 20 and 29 under 35 U.S.C. § 112(1) is invalid and should be withdrawn.

Claims 17-34 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite (Office Action, Page 4, Section 11). In response, Claims 17, 20, 26, and 29 have been amended.

Claims 17, 18, 21-23, 25-27, 30-32, and 34 were rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent No. US 7,076,443 B1 to Emens (Office Action, Page 5, Section 15). This rejection is respectfully traversed.

Claims 17 and 26 recite, inter alia, retrieving a set of sponsored content based, at least in part, on said user specific data; and integrating said sponsored content into a display generated by one from a group consisting of: an email client, an instant messaging client, and a website other than said search website.

Meanwhile, Emens explicitly discloses a product presentation manager 150 and a results presentation manager 160 which display results or products through a browser 100, and does not disclose or suggest, either explicitly or through principles of inherency, any type of e-mail client or instant messaging client. Additionally, Emens does not disclose or suggest integration into a display other than the original search website. Instead, Emens explicitly discloses the result presentation manager 160 builds a results page and sends this results page to the browser 100 (at step 99) (Emens, col. 7, lines 37-46). However, Eben's results page is part of Eben's original search website, which is in direct contradiction with the language of Claim 1. Anticipation under 35 U.S.C. §102 is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444, 221 U.S.P.Q. (BNA) 385, 388 (Fed. Cir.).

For at least the above reasons, the rejection of Claims 17 and 26, as well as all claims dependent therefrom, is invalid and should be withdrawn.

The Office Action states that “the reference invention [Emens] necessarily performs the method claim” (Office Action, Page 5, last line). This assertion is not supportable by any

possible interpretation of Emens. To support this assertion, the Office Action cites Emens col. 2, lines 61-67, which discusses formatting and displaying related advertisements within a single search website. As stated, Claim 1 recites, inter alia, integrating said sponsored content into a display generated by one from a group consisting of: an email client, an instant messaging client, and a website other than said search website.

The Office Action also states Emens suggests that (1) the graphical user interface comes from a website (since all content transmitted through the Internet generally comes from a website) and (2) the advertisement presented is separate from the search website (Office Action, Page 6, end of Section 16). However, part (1) is inaccurate, and even if accurate would not support part (2). Additionally, part (2) is contradicted by Emens's FIG. 3, which explicitly shows a single search engine 130 which displays results (step 98) through a browser 100. Further, Applicant is not claimed an advertisement being separate from a search website.

For at least the above reasons, the rejection of Claims 17 and 26, as well as all claims dependent therefrom, are invalid and should be withdrawn.

All remaining Claims were rejected under 35 U.S.C. § 103 as allegedly obvious over a variety of references using Emens as a base reference. However, all of these Claims either explicitly recite or depend from other Claims which recite elements or steps which as shown above are neither disclosed nor suggested by any combination of prior art, either by Emens or by any other reference. The secondary references do not cure this deficiency of Emens, and therefore any combination of Emens with any of the secondary references cannot provide the complete combination of features recited in the remaining claims.

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The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,

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